

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 55-69 are pending in the present application, Claims 55-57, 62, and 66 having been amended. Support for the amendments to Claims 55-57, 62, and 66 are believed to be self-evident and only correct minor informalities. Applicants respectfully request that the present amendment be entered. Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, Claims 55, 60, and 65 were rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention; Claims 55-69 were rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention; and Claims 55-69 were rejected under 35 U.S.C. §103(a) as unpatentable over Jackson (U.S. Patent No. 5,960,444) in view of Schloss (U.S. Patent No. 6,249,844).

With respect to the rejection of Claims 5, 60, and 65 were rejected under 35 U.S.C. §112, second paragraph, Applicants respectfully traverse the rejection. The outstanding Office Action relies on comments made in the response filed on page 10 of the Amendment filed February 15, 2007. However, these comments merely pointed out that the Office misunderstood the claims filed on September 20, 2006. In light of the claim amendments filed on February 15, 2007, that discussion became moot in view of the amended claims presented for examination. This is evidenced by the comments provided at page 10, which states

However, Applicants consider this discussion to be moot in view of the present amendment to the claims.

Furthermore, the present claims define the invention, and there is support for the amended claims in the originally filed specification at page 83, line 25 to page 87, line 10.

With respect to the comments on page 3 of the outstanding Office Action, Applicants A-1 and A-2 in their Example equates to AA and AB in the Examiner's example. In the Examiner's example, A is renamed AA and B is renamed AB. Each of AA and AB include A in its name. In Applicants example, A is renamed to A-1, and B is renamed to A-2. Each of A-1 and A-2 include A in its name. The Examiner's and Applicants' examples are the same, just the notation is different.

Accordingly, this ground for rejection should be withdrawn. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually satisfactory claim language. Applicants note that they attempted to contact the Examiner to discuss this matter, but the Examiner's voicemail message indicated that she was out of the Office until the week of August 27<sup>th</sup> because of maternity leave. Applicants would greatly appreciate the Examiner telephoning the undersigned to discuss this matter.

With respect to the rejections of Claims 55-69 under 35 U.S.C. §112, second paragraph, the antecedent basis informalities identified in the outstanding Office Action are corrected.

Applicants respectfully submit that Claims 57, 62, and 67 are not inconsistent with their respective independent claims. In non-limiting embodiments described in the specification, indexes are added to the document names. Paragraph [0374] of the published version of the specification states "the section names are automatically changed into ones consisting of the document name and indexes added thereto." Thus, there can be both names and indexes, and Claims 57, 62, and 67 are not inconsistent with their respective independent claims.

With respect to the rejection of Claim 55 as unpatentable over Jackson in view of Schloss, Applicants respectfully traverse this ground of rejection. The outstanding Office

Action states “Jackson in incorporation with Schloss is silent as to assigning the name of one of the plurality of document data used to create the first document data to the first document data, and to rename the plurality of document data used to create the first document data so as to include the name assigned to the first document data.” Applicants agree that Jackson and Schloss do not disclose or suggest every element of Claim 55.

Furthermore, the outstanding Office Action errs because it fails to show that the prior art disclose each and every element of Claim 55. The Office is called upon to cite support for the position that the claimed “a document name generating part configured to determine a name of one of the plurality of document data used to create the first document data, to assign the determined name of one of the plurality of document data used to create the first document data to the first document data, and to rename the plurality of document data used to create the first document data so as to include the name assigned to the first document data” is old and known in the prior art. The prior art must teach or suggest every element of claimed invention. *See*, MPEP §2143.

The outstanding Office Action errs in subjectively concluding that the differences between Claim 55 and the combination of Jackson and Schloss are obvious. The Office construes Claim 55 too broadly. Claim 55 does not recite generating any name for documents. On the contrary, Claim 55 recites a document name generating part configured to determine a name of one of the plurality of document data used to create the first document data, to assign the determined name of one of the plurality of document data used to create the first document data to the first document data, and to rename the plurality of document data used to create the first document data so as to include the name assigned to the first document data. None of the words of the claim can be ignored. In re Wilson, 165 USPQ 494, 496 (CCPA 1975).

The outstanding Office Action states "The subjective interpretation of the names does not patentably distinguish the claimed invention." The end names of the documents are not what are being claimed. On the contrary, a document name generating part that is configured to implement a novel and non-obvious algorithm for naming the first document data, and the plurality of document data used to create the first document data is what is being claimed.

Furthermore, the Office improperly relies on mere subjective conclusions and unknown authority to support its position. No evidence is provided to justify the legal conclusion of obviousness.

In this regard, it is noted that substitution of an improper subjective conclusion as to knowledge in the art for concrete evidence of such knowledge relative to a core factual finding required for a determination of patentability is clearly improper. See In re Zurko, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) as follows:

Finally, the deficiencies of the cited references cannot be remedied by the [PTO's] general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art. As described above, the [PTO] contended that even if the cited UNIX and FILER2 references did not disclose a trusted path, "it is basic knowledge that communication in trusted environments is performed over trusted paths" and, moreover, verifying the trusted command in UNIX over a trusted path is "nothing more than good common sense." *Ex parte Zurko*, slip op. at 8. We cannot accept these findings by the [PTO]. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the [PTO] clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the [PTO] cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the [PTO] must point to some concrete evidence in the record in support of these findings. [Emphasis added.]

The even more recent Lee decision by the Federal Circuit Court of Appeals (In re Lee, 61 USPQ2d, 1430, 1435 (2002)) is noted to emphasize the need for the PTO to provide actual evidence on the record, not mere unsupported opinion, as follows:

In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that of the person of ordinary skill in the art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. [Emphasis added.]

The Lee court further specifically found it to be erroneous and arbitrary conduct for the PTO to attempt to resolve questions material to patentability by reliance upon "subjective belief and unknown authority" (see In re Lee at 61 USPQ2d 1434) as is being done here. Also note the Kotzab court admonition (at 55 USPQ2d 1317) that "[b]road conclusory statements are not evidence."

Furthermore, see the Supreme Court's recent decision in the KSR case, in which the Court states "To facilitate review, this analysis should be made explicit. See In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obvious-ness')." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (U.S. 2007).

Thus, the outstanding grounds of rejection should be withdrawn because they lack concrete evidence to buttress the mere conclusory statement as to obviousness.

Claims 60 and 65, although of different statutory classes, also patentably distinguish over Jackson and Schloss, taken alone or in proper combination for at least the reasons stated above.

Furthermore, Claim 60 is directed toward a method claim, and explicitly requires “determining a name of one of the plurality of document data used to create the first document data; assigning a name to the first document data that is the name of one of the plurality of document data used to create the first document data determined in the determining step; and renaming the plurality of document data used to create the second document data so as to include the name assigned to the first document data.” To anticipate or make obvious Claim 60, the prior art must disclose or suggest the performance of these steps. The Office cannot only look to the end result (naming of documents) and conclude that it is inherent that the claimed steps were carried out. In this regard, it is well established that inherency requires the certainty that something will happen, not merely a possibility or even a probability that something may occur. See In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) and In re Oelrich, 212 USPQ 323, 326 (CCPA 1981).

In view of the above-noted distinctions, Applicants respectfully submit that Claims 55, 60, and 65 (and any claims dependent thereon) patentably distinguish over Jackson and Schloss, taken alone or in proper combination.

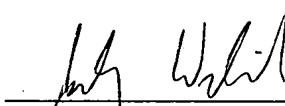
Should the above distinctions be found unpersuasive, Applicants respectfully request that the Examiner provide an explanation via Advisory Action pursuant to MPEP § 714.13 specifically rebutting the points raised herein for purposes of facilitating the appeal process.

Application No. 10/601,645  
Reply to Office Action of May 18, 2007

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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